

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor:	Jeffrey Mark Zucker, et al.	§	Atty.Dkt.No.:	6057-37702
Serial Number:	09/100,671	§	Examiner:	Retta, Yehdega
Filing Date:	6/19/1998	§	Group/Art Unit:	3622
Title:	THIRD PARTY PRIVACY SYSTEM	§	Conf. No.:	8812
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PETITION OF RESTRICTION REQUIREMENT

Dear Sir/Madame:

This paper is submitted in order to petition the restriction requirement asserted by the Examiner in the above-indicated application. The Examiner asserted a restriction requirement in the Office Action of 3/06/2008. Applicant's response on 5/06/2008 included a traversal of the restriction requirement. The restriction requirement was made final in the Office Action of 7/29/2008. Applicant respectfully disagrees with the restriction requirement and petitions for its withdrawal for the following reasons.

In the 3/06/08 Office Action, at pages 2-3, the Examiner identified the following four groups:

- I. Claims 87-92, drawn to financial institution receiving a pseudo credit account identifier that was established by the financial institution, classified in class 705, subclass 74.
- II. Claims 93-122, drawn to a privacy server configured to provide the seller fictitious payment information not usable to determine any of the set of information associated with the actual form of payment, classified in class 705, subclass 79.

- III. Claims 123-132, drawn to privacy server configured to facilitate a transaction such that each of the entities have access to at least one of but not all of the information, classified in class 705, subclass 74.
- IV. Claims 133-147, drawn to retrieving an alias payment information in response to receiving identifier from the seller and providing the alias payment information to the seller, classified in class 705, subclass 74.

Furthermore, at pages 3-5 of that same Office Action, the Examiner stated that:

- (A) “[i]nventions I and II, III are related as combination and subcombination,”
- (B) “[i]nventions IV and I are related as combination and subcombination,”
- (C) “[i]nventions IV and II III are related as combination and subcombination,”
and
- (D) “[i]nventions II and III” are related as subcombinations disclosed as usable together.

In the 5/06/2008 Response, Applicants canceled claims 133-147 which were identified by the Examiner as readable on group IV. As such, the restriction (B) between groups IV and I and the restriction (C) between groups IV and II, III are moot. With respect to the remaining restrictions, i.e., restrictions (A) and (D), Applicants elected group I with traverse.¹ The Examiner identified claims 87-92 as readable on group I. Applicant also notes that claims 148-159, added in the Applicant’s response of 5/06/2008, are also readable on group I, a fact which the Examiner has acknowledged by examining these claims along with claims 87-92 in the 7/20/08 Office Action.

Restriction (A) between Groups I and II, III

The Examiner asserted that “[i]nventions I and II, III are related as combination and subcombination.”² Applicant respectfully disagrees. Group I claims are all *method* claims, while Groups II and III claims are all *system* claims. Applicant therefore submits that groups I

¹ Nothing in the present remarks is to be taken as any type of statement or admission regarding the patentable distinctiveness of any of the pending claims vis-à-vis one another.

² See the 3/06/08 Office Action at page 3, line 7.

and II and groups I and III cannot have the relationships alleged by the Examiner. “A combination is an organization of which a subcombination or element is a part.”³ Thus, a part of a method may be a subcombination of that method, or, a part of system may be a subcombination of that system, but a system cannot be a subcombination of a method. Therefore, the Examiner’s restriction between “groups I and II, III” is not valid.

Restriction (D) between Groups II and III

The Examiner asserted that “[i]nventions II and III” are related as subcombinations disclosed as usable together.⁴ Applicant respectfully disagrees. For subcombinations to be restrictable as “subcombinations usable together,” they cannot overlap in scope.⁵ For example, given a bicycle that includes a seat and a gear mechanism, a subcombination claim directed to the seat and a subcombination claim directed to the gear mechanism might be written so that they do not overlap in scope. Here, however, groups II and III, alleged to be restrictable as subcombinations usable together, *clearly overlap in scope*, as both groups are directed to systems comprising “a privacy server” (see, e.g., claims 93 and 123).⁶ For example, the system illustrated in Applicant’s Figure 1 and correspondingly described in the specification falls within the scope of claim 92 of Group II and claim 123 of Group III. Thus, the restriction between groups II and II is not valid.

Additionally, Applicant submits that the Examiner has not established a “serious burden” if the restriction were not maintained. By the Examiner’s own classification, groups I and III are admittedly in the same subclass, and all groups are in the same class. It is not clear that separate searches need be performed.

In the 7/20/08 Office Action, the Examiner responds to Applicant’s traversal of the restriction requirement by merely quoting a number of sections from the MPEP, e.g., MPEP 806.05(c), 806.05(j), 806.05(a), 808.02, but fails to explain how any of these quotations serve to contradict Applicant arguments against restriction restated above. Indeed, Applicant believes

³ See MPEP § 806.05(a)

⁴ See the 3/06/08 Office Action at page 5.

⁵ See MPEP § 806.05(d).

⁶ Again, the mere fact that two alleged groups overlap in scope is not to be construed as any type of admission regarding the patentable distinctiveness of groups II and III vis-à-vis one another; Applicant is merely noting that the Examiner has failed to make out a restriction requirement that follows the guidelines set forth in the MPEP.

that nothing in these quoted sections diminish the force of Applicant's arguments against restriction.

CONCLUSION

The Commissioner is authorized to charge any fees that may be required, or credit any overpayment, to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account No. 501505/6057-37702/MKB.

Respectfully submitted,

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